

REMARKS

Formal Matters

Claims 11-13 and 16-22 are pending after entry of the amendments set forth herein

Claims 11-17 were examined. Claims 11-17 were rejected. No claims were allowed.

Claims 1-10 and 14-15 have been canceled without prejudice.

Claim 11 has been amended. Support for the amendments can be found in the claims as originally filed and throughout the specification at, for example: page 36, paragraph [00137].

New Claim 18-22 has been added. Support for new Claim 18-22 can be found in the claims as originally filed and throughout the specification at, for example, Claim 18: Original Claims 11-13, page 14, paragraphs [0059] and [0060]; Claim 19: original Claim 12; Claim 20: original Claim 13; Claim 21: original Claim 16; and Claim 22: original Claim 17.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

No new matter has been added.

Rejection under 35 U.S.C. § 112, second paragraph

Claims 11-15 have been rejected under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. In view of the amendments to the claims and remarks made herein, this rejection is respectfully traversed.

In particular, the Office Action asserts that Claim 11 lacks clarity with respect to the resins and the metal ions. Without conceding to the correctness of the rejection, Claim 11 has been amended for clarity to address the Examiner's objections. Support for the amendment can be found in the specification at, for example, page 36, paragraph [00137].

In addition, the Office Action objects to claims 12-15 as being redundant. Claims 13 and 14 have been canceled, rendering this rejection moot.

Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Rejection Under Obvious-Type Double Patenting

Claims 11-17 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-12 and 21-23 of U.S. Patent No. 6,703,498. This rejection is respectfully traversed as applied and as it may be applied to the pending claims.

The Examiner has raised this rejection based on the assertion that the claims of the present application are not patentably distinct from claims 1-12 and 21-23 of U.S. Patent No. 6,703,498.

However, as noted above, the claims of the present application are directed to a kit for purifying a protein. The kit must include two distinct compositions, where the first composition comprises a first metal ion chelate resin comprising a first immobilized metal ion and the second composition comprising a second metal ion chelate resin comprising a second immobilized metal ion.

In contrast to the claims of the present applicant, the cited reference is directed to a water-soluble polymeric metal ion affinity compound comprising an aspartate-based metal chelating ligand bonded to a water-soluble polymeric substance, wherein the ligand is complexed with a metal ion.

None of the claims of the cited patent are directed to a kit having two different compositions. Furthermore, the claims of the present application do not require the presence of the water-soluble composition of the cited patent.

As such, the claims of the present application are not an obvious variant of the claims of the cited patent. Therefore, the Applicants respectfully request that this rejection be withdrawn.

Rejection under 35 U.S.C. § 102(b)

Claims 11-17 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Porath et al., Biochemistry 22:1621-1630 (1983) (hereafter "Porath et al.").

As noted above, the claims of the present application are directed to a kit for purifying a protein comprising a first composition comprising a first metal ion chelate resin comprising a first immobilized metal ion and a second composition comprising a second metal ion chelate resin comprising a second immobilized metal ion. As such, the two elements are provided in a single kit for purifying a protein.

In contrast, Porath et al. discloses differential affinity of serum protein to gel-immobilized iron or gel immobilized nickel ions. Porath et al. fails to disclose in a single kit for purifying a protein comprising a first composition and a second composition as claimed in the present application.

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987), cert. denied, 481 U.S. 1052 (1987). See also, Scripps Clinic and Research Foundation v. Genentech, Inc., 18 USPQ 2d 1001 (Fed. Cir. 1991).

Since Porath et al. does not teach a single kit comprising the first and second compositions, the cited reference fails to disclose every element found in the claims of the present invention. As such, claims 11-17 are not anticipated under 35 U.S.C. § 102 by the cited reference. Therefore, the Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: May 12, 2005

By: 

Bret E. Field
Registration No. 37,620

BOZICEVIC, FIELD & FRANCIS LLP
1900 University Avenue, Suite 200
East Palo Alto, CA 94303
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

F:\DOCUMENT\CLON\056us2\Amendment in resp to OA 2-23-05 CLON-056US2.DOC